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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/011,634 | 04/03/1998 | MARC ARONHIME | P16370 | 1164 |

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| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1774 | 27 |

DATE MAILED: 07/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/011,634 | ARONHIME ET AL. |
| | Examiner | Art Unit |
| | Michael E. Grendzynski | 1774 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 18 December 2001.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 29-45 and 66-79 is/are pending in the application.

4a) Of the above claim(s) 77-79 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 29-45 and 66-76 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>26</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>22</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdrawal of Finality

1. Due the new grounds of rejection, articulated below, the finality of the rejection of the last Office action is withdrawn.

Election/Restrictions

2. To reiterate the record, applicants argue that since claims 77-79 depend from claim 29, they must contain the same technical feature as claims 29 since, obviously, they contain all the limitations of claim 29. Examiner agrees that claims 77-79 contain the same technical feature of claim 29; however, this technical feature does not define a contribution over the prior art. As a result, lack of unity exists. As defined by PCT Rules 13.1-13.4 and 37 CFR 1.475, unity exists where there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features *which define a contribution over the prior art*. The rule, then, requires not only that the relationship exists (i.e., that they are unified by a special technical feature), but also that the special technical feature which unites the claims defines a contribution over the prior art. In the instant case, although there is a special technical relationship between the claimed inventions, the special technical feature that creates this relationship does not define a contribution over the prior art. Consequently, the lack of unity requirement is deemed appropriate.

Specification

3. The amendment filed 12/18/01 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material that is not supported by the original disclosure is as

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follows: Applicants amend the specification by adding a paragraph that defines new properties to the release layer, namely, a non-tacky property. This property is neither disclosed in the specification as originally filed, nor is it a property that is inherently possessed by the layer. Applicants have submitted an affidavit of Mr. Aronhime (paper No. 20.), which examiner has carefully considered. Applicants argue that the affidavit is evidence that the release coating of the instant invention is inherently non-tacky. This affidavit, however, does not evidence such an inherent property. In the affidavit, applicants state no tackifiers where used in the outer release coating. The claim language, however, does not exclude the presence of tackifiers. The specification on p 22, moreover, discloses that the release coating may include silicone oil, which is a known tackifier. In addition, applicants argue that the normal conditions of operation include only liquid toner imaging operations. The specification on p 28, however, discloses the use of the instant invention in conditions other than these argued "normal conditions," i.e., in conditions including powder systems. It does not necessarily flow that the claimed release layer is non-tacky. Consequently, the affidavit does not evidence that the release coating of the transfer blanket is inherently non-tacky.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. With regard to the rejection of claims 42-44, this rejection is withdrawn. Examiner thanks applicants for further clarifying the claims. Examiner will read the term "comprising" as "further comprising."

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 19-45 and 66-76 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims include the limitation that the outer release layer is non-tacky. As explained above, this limitation is not disclosed in the specification, nor is this property inherent in the layer coating.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 29-41 and 66-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Presently, the exact composition of the release layer is unclear. As noted above, the release layer, though having a non-tacky property, may comprise tackifiers. It is not clear how much of a specific tackifier may be present for the layer to retain its non-tacky property. The specification is silent with regard to this; moreover, due to the endless permeations involving any compound which can serve as a tackifier, this property would not be obvious to one of ordinary skill in the art. Claims merely setting forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics are invalid as vague, indefinite, and functional, since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future and which would impart desired characteristics. *Ex Parte Slob*, 157 USPQ 172 (1967).

With specific regard to claims 43 and 72-74, the phrase "in an amount greater than that normally used for the polymerization" renders the claim ambiguous. The "normal amount" is not defined in the specification, nor does it have a well-defined meaning in the art. Consequently, the metes and bounds of the claim cannot be ascertained. Applicants argue that for each combination of silicone polymer material and cross-linking agent, a recommended ratio exists. It remains the examiner's position that, without

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undue experimentation, one skilled in the art would not readily appreciate the numerous variations of combinations and, in particular, the ‘normal’ amount of cross-linking agent or catalyst required for each combination. It is suggested that applicants provide further evidence that the above-mentioned combinations are known in the art.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 29, 39-41 and 76 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ryoichi (JP 57-020742). *See Abstract.* Ryoichi does not require filler material in its surface tacky layer; consequently, it meets applicants claimed filler values. With regard to the claimed non-tacky property and liquid toner receptive properties, “it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.” *In re Swinehart et al.*, 169 USPQ 226 at 229. Since the Ryoichi member teaches all of applicants’ claimed compositional and positional limitations, it is inherent that the member functions in the manner claimed by applicants. That is, since the member comprises all of applicants’ claimed components in the same amounts as claimed by applicants (e.g., a layer comprising condensation cured silicone, no fillers and a silicone oil in an amount of less than 40 weight percent), it is inherent that the member functions in the manner claimed by applicants, i.e., that it possesses the claimed non-tacky property. The burden is upon the “applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon.” To date, this burden has not been sustained.

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11. Claims 29-33, 35-41 and 76 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang (US 5114520). Applicants claim an image transfer member suitable for the transfer of toner images comprising a base layer and a non-tacky outer release layer comprised of a condensation cured silicone. Wang discloses an image transfer apparatus for use with liquid toners comprising a carrier sheet including a substrate and a release layer. *See col. 5, l 48 through col. 6, l 38.* The release coating is equivalent to applicants' release coating. It comprises a condensation-cured silicone. *See col. 6, ll 39-46.* With regard to the claimed non-tacky property, "it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." *In re Swinehart et al.*, 169 USPQ 226 at 229. Since the Wang member teaches all of applicants' claimed compositional and positional limitations, it is inherent that the member functions in the manner claimed by applicants. That is, since the member comprises all of applicants' claimed components in the same amounts as claimed by applicants (e.g., a layer comprising condensation cured silicone, no fillers and a silicone oil in an amount of less than 40 weight percent), it is inherent that the member functions in the manner claimed by applicants, i.e., that it possesses the claimed non-tacky property. The burden is upon the "applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon." To date, this burden has not been sustained.

With regard to claims 30-33, Wang discloses the thickness of its release layer is within an amount claimed by applicants. *See col. 7, ll 11-14.*

With regard to claims 35-41, Wang does not include filler materials or silicone oil in its release layer; consequently, it meets applicants' claimed values for these materials.

12. Claims 29-44, 66-74 and 76 are rejected under 35 U.S.C. 102(b) as being anticipated by Namiki (Ricoh Co) (JP- 57-19753) (Translation provided by applicants). Applicants claim an image transfer member suitable for the transfer of toner images comprising a base layer and a non-tacky outer release layer comprised of a condensation cured silicone. Namiki (Ricoh Co) discloses a transfer member

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comprising a substrate and a layer of silicone rubber. *See Translation*, pp 2-3 and p 15. The layer of silicone rubber is equivalent to applicants' release coating—it comprises a condensation-cured silicone. *See Translation*, pp 3-4. The layer of silicone rubber further comprises a cross-linking agent and, optionally, fillers. *See p 4.* The layer of silicone rubber, moreover, possesses a thickness value within the value claimed by applicants (5 µm or more). *See Translation*, p 15. With regard to the claimed non-tacky and liquid toner absorbing properties, "it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." *In re Swinehart et al.*, 169 USPQ 226 at 229. Since the Namiki (Ricoh Co.) member teaches all of applicants' claimed compositional and positional limitations, it is inherent that the member functions in the manner claimed by applicants. That is, since the member comprises all of applicants' claimed components in the same amounts as claimed by applicants (e.g., a layer comprising condensation cured silicone, no fillers and a silicone oil in an amount of less than 40 weight percent), it is inherent that the member functions in the manner claimed by applicants, i.e., that it possesses the claimed non-tacky property. The burden is upon the "applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon." To date, this burden has not been sustained. Applicants argue that since the release layer of the instant invention inherently does not use a tackifier that it is, in turn, inherently non-tacky. This argument, however, is not found persuasive. The use of the transitional term "comprising" does not prohibit tackifiers from existing in the layer. In addition, as noted above, the specification specifically discloses that silicone oil—a known tackifier—may be present in an amount falling within the amount used by Namiki.

With specific regard to claims 35-38, Namiki (Ricoh Co) discloses that its layer of silicone rubber comprises silicone oil within an amount claimed by applicants. *See p 14* (disclosing silicone oil is present

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as an adjusting agent) and p 15 (disclosing the adjusting agent is present in an amount of 40% by weight or less of other components).

With specific regard to claims 39-41, since the layer of silicone rubber need not comprise fillers (they are optional), fillers are present in an amount claimed by the applicant (i.e., zero percent).

With specific regard to claims 43 and 72-74, Namiki discloses the use of a catalyst (platinum).

See Translation, p 6 and Examples 1-3.

With specific regard to claim 44, Namiki (Ricoh Co) discloses its silicone rubber layer comprises iron oxide, zinc oxide, nickel oxide, and rare earth elements. *See Translation, p 13.* These are all conductive materials.

With specific regard to claim 71, Namiki discloses the use of an ethyl silicate cross-linker. *See Translation, p5 and Example 3.*

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Namiki (Ricoh Co), as applied to claims 29-44, 66-74 and 76, above, in further view of Schank (US 4595602), Seimiya (US 4511622 and Sakoh (US 5114814). The use of an anchor layer to improve the adhesion between layers of a transfer blanket is well known in the art. Schank, Seimiya and Sakoh evidence that anchor layers are well known. *See Schank at col. 8, ll 38-45; Seimiya at col. 2, ll 62-66 and Sakoh at col. 12, ll 15-21.* Consequently, it would have been obvious to one of ordinary skill in the art at the time of the invention to

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place an anchor layer in the structure of Ricoh Co., motivated by the desire of improving the adhesion between layers.

15. Claim 75 is rejected under 35 U.S.C. 103(a) as being unpatentable over Namiki (Ricoh Co), as applied to claims 29-44, 66-74 and 76, above, in further view of Badesha (US 5340679). Carbon black is a well-known filler in the art, used interchangeably with other fillers such as iron oxide and silica. See Badesha at col. 1, ll 45-50. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention to use carbon black as the filler or stabilizer of Namiki.

16. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US 5114520), as applied to claims 29-33 and 35-41, above. It would be obvious to one of ordinary skill in the art at the time of the invention that a thickness of 2 μm (disclosed by Wang) would be contemplated by a thickness of “about 3 μm .”

17. Claims 29-45 and 66-70 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hendrickson for the reasons of record. Applicants argue that the phrase “suitable for the transfer of toner images” is a functional limitation that distinguishes the instant invention over this reference. Upon further consideration, examiner agrees the language is functional, and not language of intended use. Giving the phrase, its broadest, reasonable interpretation consistent with the specification, to be suitable for the transfer of an image, the image only needs to transfer once. As already made of record, the image or Hendrickson, at the very least, meets this limitation. Consequently, the rejection is maintained.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Grendzynski whose telephone number is 703-305-0593. The examiner can normally be reached on weekdays, from 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.



BRUCE H. HESS
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Michael E. Grendzynski
Assistant Examiner
July 8, 2002